

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-25 are pending in this application, Claims 8-24 having previously been withdrawn from consideration. No new matter is added.

In the outstanding Official Action, Claims 1-7 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,111,299 to Aoki et al. (hereinafter Aoki) in view of U.S. Patent No. 5,898,434 to Small et al. (hereinafter Small).

The Official Action cites Aoki as disclosing the Applicant's invention with the exception of the claimed details regarding the recording and playback buttons displayed on the first and second user interfaces. The Official Action cites Small as disclosing this claimed feature and asserts that it would have been obvious at the time of the invention to combine the cited references to arrive at Applicants claims. Applicants respectfully traverse this rejection as Small fails to teach or suggest the claimed features for which it asserted as a secondary reference under 35 U.S.C. § 103, and there is no motivation to modify Aoki by incorporating features of Small's system.

Independent Claim 1 recites an information processing apparatus, comprising

recording unit configured to record a first supplied picture;

reproducing unit configured to reproduce a second recorded picture;

display controlling unit configured to provide display control in such a manner as to display a first user interface when said recording unit records said first picture supplied and to display a second user interface when said reproducing unit reproduces said second picture recorded;

wherein said first user interface displays *a recording button through which to input orders for operating said recording unit and a playback button through which to input orders for operating said reproducing unit* and said second user interface displays *a recording button through which to input orders for operating said recording unit and a playback*

button through which to input orders for operating said reproducing unit.

As shown in an exemplary embodiment at Figs. 9-10 and 16-17, a first interface for image recording and a second interface for image reproduction both include a recording button to operate the recording unit and a playback button to operate the reproducing unit.

Independent Claims 6, 7 and 25, while directed to alternative embodiments, recite substantially similar features. Accordingly, the arguments presented below are applicable to each of independent Claims 1, 6, 7 and 25.

As admitted in the Official Action, Aoki fails to teach or suggest the above emphasized claimed features directed to the button configuration of the user interfaces. In an attempt to remedy this deficiency, the Official Action cites Fig. 11 and col. 15, line 49-col. 16, line 3 of Small.

This cited portion of Small is directed to using an active sound element (178) to mark and associate an image with an instance of the element using sound dialogue box (180). Specifically, a user associates a picture (182) to the sound element by using the record button (184) to activate a recorder of the computer, and the user could then playback the recorded sound by selecting play button (186), or by selecting the instance of the sound element attached to the picture.

Small, however, fails to teach or suggest a first user interface and a second interface, which both display ***a recording button through which to input orders for operating said recording unit*** [configured to record a first supplied picture] ***and a playback button through which to input orders for operating said reproducing unit*** [to reproduce a second recorded picture], as recited in independent Claim 1.

Instead, the cited portion of Small is directed to allowing a user to mark a photograph or some other image with a sound element by way of the sound dialogue box (180). Claim 1, in contrast, recites that the first and second user interfaces display a recording button through

which to input orders to operate the recording unit *configured to record a picture*, and a playback button through which to input orders for operating said reproducing unit *configured to reproduce a second recorded picture*. As noted above, Small describes a sound dialogue box (180) that provides a record button (184) to record speech or some other sound and a play button (186) allowing the user to play the recorded sound.

At no point does Small teach or suggest a first user interface and a second interface, as recited in Claim 1, that both display a recording button through which to input orders for operating said recording unit, which is *configured to record a first supplied picture*, and a playback button through which to input orders for operating said reproducing unit, which is configured *to reproduce a second recorded picture*. Instead, as noted above, Small's system is not configured to display buttons that allow for the recording of a picture and the reproduction of a picture, whatsoever.

Further, Applicants respectfully traverse the obviousness rejection based on Aoki and Small because there is insufficient evidence for a motivation to modify Aoki's still video camera by incorporating Small's system for marking data stored in a computer system, for the following reasons.

The outstanding Office Action states that the proposed modification would have been obvious "to modify Aoki by realizing Aoki (sic) with the means to select different interfaces for selected different sounds since this provides the desirable advantage of facilitating the playing/recording, for example, of the different sounds... using different interface modes"¹ The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification. While Small may provide a reason for using an interface to record a sound to mark data stored in a computer system, the reference fails to suggest why a person of ordinary skill in the art would be motivated to incorporate

¹ Outstanding Official Action, p. 4.

such a feature in a video camera such as the one disclosed in Aoki. In particular, Small uses a computer and the sound dialogue box (180) to record and playback sound clips which are associated with data stored in the computer system. Small, however, does not suggest that marking particular data using a computer interface would work in a video camera, much less “facilitating the playing/recording ...of the different sounds” in a video camera.

In addition, Aoki is not concerned with being provided with an interface to record sound clips to mark data, whatsoever. Instead, Aoki is concerned with mode or setting changing in a compact video camera. Aoki states that its structure already achieves the goal to “minimize the number of operating members which are used to actuate the changing or setting of various functions and modes of a camera.”² Aoki does not suggest that another feature should be added to allow for the marking data with recorded sound via a sound dialogue box.

Furthermore, it is not clear from the record how Small's sound dialogue box and method for marking stored data clips with sound could be incorporated into Aoki's device. Under such a modification, Aoki's video camera would have to be implemented with a larger more complex user interface and display, and also include an additional processor and software functionality to perform the marking procedure, as described in Small. More specifically, Small's system is intended to be implemented on a user's personal computer, which has significantly more processing power and user interface features than that of a video camera that is configured to “minimize the number of operating members.” Such modification would require a substantial reconstruction or redesign of the elements of Aoki's camera. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.

² Aoki, col. 3, lines 3-5.

Aoki and Small, therefore, do not provide the motivation to perform the proposed modification of Aoki's camera. In other words, an attempt to bring in the isolated teaching of Small's sound marking system into Aoki's camera would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole. While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, the record fails to support the proposed modification of Aoki.

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record, and by "clear and particular" evidence of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Aoki's camera by incorporating Small's sound marking system. Without such motivation and absent improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-7 and 25 are believed to be non-obvious and patentable over the applied prior art.

Accordingly, at least for the reasons discussed above, Applicants respectfully request that the rejection of Claims 1-7 and 25 under 35 U.S.C. § 103 be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-7 and 25 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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